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Victor S. Chan

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IBM CORP. (WSM)

c/o WINSTEAD SECHREST & MINICK P.C.

P.O. BOX 50784

DALLAS, TX 75201

EXAMINER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/773,496  
Filing Date: February 06, 2004  
Appellant(s): CHAN ET AL.

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Robert A. Voigt, Jr.  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed March 29, 2009 appealing from the Office action mailed October 07, 2008.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct with the addition of the New Ground of Rejection discussed below

**NEW GROUND(S) OF REJECTION**

Claims 1 – 7 and 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

<b>WO01/29716 A2</b>	<b>WESTROPE</b>	<b>04-2001</b>
<b>7,136,871</b>	<b>OZER et al</b>	<b>11-2006</b>

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

**NEW GROUND(S) OF REJECTION**

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 – 7 and 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent, to be patent eligible under 35 U.S.C. 101 a method/process claim must (1) be tied to a particular machine or apparatus or (2) transform a particular article into a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 70 (1972); *Diamond v. Diehr*, 450 U.S. 192 (1981); *Parker v. Flook*, 437 U.S. 589 n.9 (1978); and *Cochrane v. Deener*, 94 U.S. 780, 788 (1876)). Furthermore, the Supreme Court held that the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patentability (*Benson*, 409 U.S. 71-72). The involvement of the machine or

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transformation must not merely be insignificant extra-solution activity (Flook, 437 U.S. 590). Also see *In re Bilski*, No. 2007-1130, F.3d, 2008 WL4757.

The instant claims 1-7 and 22 fail to meet this test. The claims fail to transform a particular article into a different state or thing. The claims are not tied to a machine or apparatus. In order for a process claim to be considered statutory subject matter under 35 USC 101, the process must be tied to a machine *within the body* of the claim, and the machine must be performing *an essential function* within the claim.

**(a)** Claims 1-4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Westrope (WO 01/29716 A2).

Claims 1 Westrope discloses a system, method, and program for managing content on a virtual store, comprising:

- a. creating a template (presentation layout templates) upon which store web page displays are formatted (page 9, lines 1-14);
- b. designating one or more e-marketing spots in the hosted stores (media outlets) (page 9, lines 1-14);
- c. setting up a marketing campaign for the stores (page 8, lines 15-30 and page 10, lines 12-13); and
- d. creating one or more campaign initiatives (e.g. start/end dates and times) for the content to be displayed in the stores (page 10, lines 17-31).

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Claim 2: Westrope discloses a system, method, and program as in Claim 1 above, and further discloses creating local campaign initiatives for content to be displayed in the e-marketing spots of the stores (page 16, lines 23-30).

Claim 3: Westrope discloses a program and method as in Claim 2 above, and further discloses modifying the local campaign initiatives in the store (page 15, lines 9-13).

Claims 4 Westrope disclose a system, method, and program as in Claims 2, above, and further discloses scheduling a time duration (start/end dates and times) for the content display (page 10, lines 20-31 ).

Claims 7: Westrope discloses a program and method as in Claims 1 above, and further discloses modifying the campaign initiatives in the store (page 12, lines 6-24 and page 15, lines 9-13).

**(b)** Claims 5, 6, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Westrope (WO 2001/29716 A2) in view of Ozer et al (7,136,871).

Claims 5: Westrope discloses a system, method and program as in Claim 4 above, and further implies checking for schedule conflicts between the campaign initiatives by displaying a campaign docket summary in calendar form which the media licensees (stores) and creator (advertiser) use to design and modify their campaigns (page 11,

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line 18 - page 12, line 24). Ozer discloses a similar system, method, and program for managing marketing campaigns in which several techniques are disclosed for conflict resolution between a plurality of advertisements within a marketing campaign (column 3, lines 49-57; column 5, lines 61-67; and column 17, lines 34-44). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Westrope to use one or more of these techniques to determine and resolve scheduling conflicts between the various local and national marketing campaigns shown on the campaign docket summary. One would have been motivated to check for and to resolve such conflicts in order to allow the completion within the designated contractual agreements of the marketing campaigns.

Claims 6: Westrope and Ozer disclose a program and method as in Claim 5 above, and Ozer further discloses the "local advertisements will be treated as committed advertisements and given absolute weightings, while the national and default advertisements will be used as flexible advertisements, which are given relative weightings" (column 29, lines 42-53). In one embodiment, Ozer discloses first scheduling the committed advertisements; then, if all the time slots are not taken, filling the remaining time slots with the flexible advertisements (column 28, line 58 – column 29, line 8). However, Ozer also discloses that the national advertiser could also set up the national advertisements as committed advertisements. Additionally, the Examiner notes that the decision of which advertisement (campaign initiative) would have priority would be up to the operator of the system. If only one advertisement could be shown,

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then the operator would have two choices - show the local advertisement or show the other advertisement. Official Notice is taken that such decisions are old and well known within the advertising arts. For example, for at least several decades, local television stations have routinely substituted local advertisement spots for nationally broadcast advertisements. They have also routinely substituted regional or national public alert messages in place of local advertisements/programs. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for the operator in Westrope to select the (national) campaign initiative over the local campaign initiative. One would have been motivated to choose the national campaign initiative over the local campaign initiative in order to allow the store to receive the monetary compensation from the national advertiser and to meet its contractual obligations.

Claim 22: Westrope discloses a method of:

- accessing a list of pre-defined e-marketing spots for a profile store;

- creating an e-marketing spot for said profile store by selecting said e-marketing spot from said list of pre-defined e-marketing spots; (pages 6, lines 14-30 and pages 9, lines 1-14);

- accessing a first list of pre-defined campaign initiatives for said profile store;

- creating a campaign initiative for said profile store by selecting said campaign -initiative from said first list of campaign initiatives (page 8, lines 15-30 and pages 9, lines 1-14);



accessing a second list of campaign initiatives for a hosted store; creating a campaign initiative for said hosted store by selecting said campaign initiative from said second list of campaign initiatives (page 8, lines 15-30 and pages 9, lines 1-14);

selecting said e-marketing spot created for said profile store to an e-marketing spot in said hosted store; (pages 9, lines 1-14);

scheduling said campaign initiative created for said profile store to said e-marketing spot in said hosted store; (page 10, lines 17-31); and

scheduling said campaign initiative created for said hosted store to said e-marketing spot in said hosted store; (page 10, lines 17-31).

Westrope does not explicitly disclose rejecting said scheduling of said campaign initiative created for said hosted store if there is a conflict between said campaign initiative created for said profile store and said campaign initiative created for said hosted store.

However Oser teaches rejecting said scheduling of said campaign initiative created for said hosted store if there is a conflict between said campaign initiative created for said profile store and said campaign initiative created for said hosted store. (column 3, lines 49-57; column 5, lines 61-67; and column 17, lines 34-44).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Westrope to use one or more of these techniques to determine and resolve scheduling conflicts between campaign initiative created for said profile store and said campaign initiative created for said hosted store.

**(10) Response to Argument**

**(a)** In response to appellant's arguments, the appellant states, that the claim language in the preamble of claim 1 is clearly limiting, by specifying that virtual stores are stored in databases that are managed by a database management system in a resource manager. The appellant further states that the limitations of claim 1 are limiting by specifying that the graphical user interface is operatively connected to an application server having a business logic module to select the content to be displayed. The Examiner maintains his arguments from the previous office action, that the preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Therefore since the appellant's preamble does not include language that ties the preamble to the body of the claim, examiner maintains that the preamble does not further limit and thus was not given patentable weight.

**(b)** The appellant argues that the system disclosed by Westrope fails to disclose, "creating a profile store and creating a profile store which serves as a template and upon which the hosted stores are formatted." The examiner notes that on page 9 lines 1-14 Westrope discloses, "...presentation layout templates allow the creator to design multiple interactive advertisements quickly and efficiently." The templates (presentation layout templates) are templates used to sell a product. Page 6, lines 1-16

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discloses, "as the owner enters filtering criteria into the system via the response fulfillment campaign interface, the system provides a list of potential media licensees meeting the chosen criteria. The media licensee list preferably contains information, such as the name, category, format and target audience, that would help the creator select an appropriate media outlet." The profile store which are templates (page 5 paragraph 4, of the appellant's specification) as the appellant has stated above are created and then assigned to the appropriate media outlet, the media outlet serves as a "hosted store."

(c) The appellant also argues that the system disclosed by Westrope fails to disclose "creating a profile store," and the appellant further states that the templates are used to create advertisements and that creating an advertisement is not creating a profile store. A profile store is a template as defined by the appellant's specification on page 6, lines 19 – 20. The Examiner notes that Westrope discloses on page 9, lines 1-14, creating templates, templates to which the appellant has clearly stated that the profile stores are templates. Also the appellant used the term profile store, however does not disclose in the specification nor in the claims that the profile store is selling a product or service. The profile store has been disclosed in claim 1 to be a template and the hosted stores are formatted from the templates making the hosted store a template as well. The appellant also states that a virtual store is a hosted store. There is no language that suggests or implies that a virtual store is a hosted store. The appellant has cited page 1, lines 17 -22, which states, "whereby a manufacturer or reseller creates a "virtual store" for conducting its business and allow buyers to purchase or

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exchange goods or services. These online stores offer a compelling shopping experience for the buyers, and as a result, manufacturers and resellers go through great lengths to ensure that the content of their online business accurately reflects the quantity and quality of the products or services offered.” In the section cited, there is no reference to a hosted store. The appellant also cites page 11, lines 1 -4 of the specification, which states, " Fig. 3 shows the organization of content to be displayed at virtual stores in a particular marketing campaign. As shown in Fig. 3, a number of stores (S 1, S2 . . . Sn) 3 10, indicated individually as 3 1 Oa, 3 1 Ob, . . . 3 1 On, participate in marketing campaign 300. The stores 310 are based on a generic profile store.” This also does not suggest or imply that a virtual store would be considered as a hosted store. The appellant also cites page 12, lines 8 – 10 of the specification, which states, “management GUI of the business logic module 205 to create an e-marketing spot for a generic profile store upon which the stores (S1 ... Sn) 310 (as shown in Fig. 3) are 10 modeled (Step 4000). This also does not suggest or imply that a virtual store would be considered as a hosted store.

**(d)** The appellant also argues that Westrope fails to disclose designating one or more e-marketing spots in the hosted stores. The appellant’s specification states that e-marketing spots serve as placeholders for content (page 11, lines 6-7). Also the appellant states that the content of said e-marketing spots are ordered based on variants such as consumer patterns or behaviors (page 11, lines 17-20), said content would be for example an advertisement. The examiner notes that Westrope discloses on page 9, lines 1-14, “Note that different docket templates may be required if the

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response fulfillment campaign uses different creative content for different advertisements (e. g., different media outlets having different creative requirements) or if the response options offered are different for different media licensees participating in the same response fulfillment campaign.” Different advertisements would be considered one or more e-marketing spots, also the media outlets are the equivalent of hosted stores.

(e) The appellant also argues that the system disclosed by Westrope fails to disclose setting up a marketing campaign for the hosted stores. Examiner notes that Westrope discloses on page 8, lines 15-30, where he discusses creating the campaign (e.g. “...docket template includes the campaign information entered by the creator...”) and on page 10, lines 12-13 it is disclosed the campaign dockets are assigned to a media license(e. g. hosted store). The appellant also argues that the system disclosed by Westrope fails to disclose creating one or more campaign initiatives in the profile store for the content to be displayed in the hosted stores. The examiner notes that Westrope discloses as stated on page 9 of the remarks submitted, that Westrope discloses that the campaign docket includes editable fields to change the frequency, placement, and insertion of advertisement in the selected media outlet. The examiner notes that the campaign docket is the equivalent of campaign initiatives. Also, on page 10 lines 17-31, “...advertisement will appear through a given media licensee...” The examiner notes that appearing through a given media licensee, would also be the equivalent of the content being displayed in a hosted store.

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**(f)** The appellant also argues that the system disclosed by Westrope fails to disclose creating one or more local campaign initiatives for the content to be displayed in the e-marketing spots of the hosted stores. The examiner notes that Westrope discloses as stated on page 10 of the remarks submitted, that Westrope discloses a media licensee (owner of hosted store) may choose to create an independent docket (campaign initiative) if it is advertising (e-marketing spots) its own products. The examiner notes that the media licensee would be the equivalent to the hosted store, the campaign docket is the equivalent of campaign initiatives, and advertisements are equivalent to e-marketing spots.

**(g)** The appellant also argues that the system disclosed by Westrope fails to disclose modifying the local campaign initiatives (docket template) in the hosted stores. The examiner notes that page 15, lines 9-13 as stated on page 11 of the remarks submitted, that Westrope discloses that "...the created can modify any field in the docket template..." The appellant also states that there is no language that discloses modifying the local campaign initiatives in the hosted stores. The appellant stated in claim 1 above, that a profile store serves as a template and upon which the hosted stores are formatted. Which suggest or implies that a hosted store is a template. The Examiner respectfully disagrees and reiterates that Westrope discloses as mentioned above that, "created can modify any field in the docket template" (docket template, i.e. a hosted store)

**(h)** The appellant also argues that the system disclosed by Westrope fails to disclose scheduling a time duration for the content to be displayed in the e-marketing

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spots of the hosted stores. The examiner notes that Westrope discloses "...editable fields to change the frequency...in a selected media outlet..." The examiner equates the ability to change the frequency as being able to schedule time duration and as stated earlier a media outlet is equivalent to a hosted store. The appellant further argues that a frequency is not the same as scheduling time duration. However Westrope discloses on page 10, lines 20 - 24 that editable fields that consist of start/end dates and times. (e.g. a time duration)

(i) The appellant also argues that the method disclosed by Ozer fails to disclose checking for a schedule conflict between one or more of the campaign initiatives for the profile store and one or more of the local campaign initiatives for an e-marketing spot in the hosted store. The Examiner respectfully disagrees, as stated in the previous office action, Ozer discloses a scheduling conflict as stated in Column 3 lines 49 – 57, "the planning module notifies the broadcaster of a conflict between currently scheduled advertisement and a requested advertising campaign's impression goal." Column 5 lines 61 – 67, "... o schedule the display of the associated advertisements to fulfill the goal, and optionally resolving conflicts between newly requested advertising campaigns and currently scheduled advertising campaigns...", column 17, lines 34-44, "Returning to FIG. 2, reservation module 32 is configured to notify an individual utilizing interface module 30 when advertising inventory is overbooked for requested target criteria. For instance, as the individual defines the advertising impression goal and specific target criteria associated with the requested advertising campaign, reservation module 32 compares current advertising inventory

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availability against the requested impression count and target criteria. Based upon this comparison, reservation module 32 identifies the various conflicts between the requested and currently committed advertising inventories." The appellant states that there is no language that teaches the limitations of claim 5. However as stated in the previous office action it would have been obvious to combine the teachings (e.g. resolving scheduling conflicts) of Ozer with the teachings of Westrope (e.g. campaign initiatives for the profile store). As stated in the previous office action and repeated here for clarity, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Westrope to use one or more of these techniques to determine and resolve scheduling conflicts between the various local and national marketing campaigns shown on the campaign docket summary. One would have been motivated to check for and to resolve such conflicts in order to allow the completion within the designated contractual agreements of the marketing campaigns.

(j) The appellant has stated that the rejection failed to address a limitation, the appellant is correct that this limitation was not explicitly addressed. However, the appellant's attention is directed to Westrope, page 9, lines 1-5, that discloses that a docket template includes presentation layout templates (e. g. e-marketing spots) from which the creator can select. The presentation layout templates determined the layout of the electronic response boxes and the advertisements. The appellant has stated in the specification that e-marketing spots are placeholders for content, said content being advertisements (appellant's specification page 15, lines 3 - 5). The appellant also states that there is no language that teaches creating an e-marketing spot for the profile



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store. The Examiner respectfully disagrees and as stated previously the appellant has disclosed that the profile store is a template (claim 1) and that an e-marketing spot is disclosed as a placeholder for content, said content disclosed as an advertisement as mentioned above.

**(k)** The appellant argues that there is no language that teaches creating a campaign initiative for the hosted stores, nor language that teaches creating a campaign initiative for the hosted store by selecting a campaign initiative from the second list of campaign initiatives. The Examiner disagrees. There is no material difference between a hosted store and a profile store. As stated previously, the appellant discloses that a profile store is a template used to generate the hosted stores (appellant's specification page 6, lines 19 & 20). The hosted stores are templates that are being used to display advertisements. The appellant is attempting to distinguish a difference between a hosted store and a profile store with mere words. There is no material difference between a hosted store and a profile store.

**(l)** The appellant argues that there is no language that discloses scheduling the campaign initiative created for the profile store. Nor is there language that discloses scheduling the campaign initiative created for the profile store to the e-marketing spot in the hosted store. The Examiner respectfully disagrees and directs the appellant to Westrope pages 6, lines 15 – 30 that discloses scheduling a campaign, created for the advertisement (e.g. e-marketing spot), also see Figure 2B. That clearly displays a scheduling of a campaign, that would be associated with an advertisement.

**(m)** The appellant argues that the Examiner has not established a prima facie case of obviousness for modifying Westrope with the teachings of Ozer as per the claim limitations of “checking for a schedule conflict between one or more of the campaign initiatives...” or “rejecting said scheduling of said campaign initiative created for said hosted store if there is a conflict...” In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner notes that even without the teaching of Ozer, it would have been obvious for Westrope to check for scheduling conflicts as would be normal when setting up any kind of schedule. In setting up advertising campaigns, it would be imperative for the media outlet with a plurality of advertising contracts with various advertisers to ensure there were no scheduling conflicts that would prevent “the completion within the designated contractual agreements of the marketing campaigns” as concluded in the final rejection. Obviously, if such a conflict was detected, the scheduling would need to be adjusted in order to alleviate the conflict, such as rejecting or revising one of the campaign initiatives. In the scheduling arts, this is known as “conflict resolution”.

**(n)** The appellant argues that “there is no language that suggests that media licensees are stores”. However, the Examiner notes that little if any patentable weight is

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given to what other endeavors may be undertaken by the media licensees. The claimed advertising campaigns are not tied to any transactions being conducted by the media licensees, and, thus whether the advertisements are presented through a radio or television broadcast or on a billboard (i.e. printed poster) does not effect the advertising campaign. (It is also noted that there is nothing in the references which would preclude the "billboard" being placed within or outside of a "store".)

### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

**(1) Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

**(2) Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of

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rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/D.P./  
May 26, 2009

/James W Myhre/  
Supervisory Patent Examiner  
Art Unit 3688

Conferees:

James W Myhre /J.M./  
Supervisory Patent Examiner, Art Unit 3688

Vincent Millin /vm/  
Appeals Practice Specialist

**A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:**

/Wynn W. Coggins/

Director, TC 3600

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